

REMARKS/ARGUMENTS

The Examiner's attention to the present application is noted with appreciation. Claim 10 is amended, and claim 15, dependent to claim 10, is added.

Inventorship

Based on the claims at issue, the sole inventor is Maarten A. de Waard. A petition pursuant to 37 CFR 1.48(b), together with the fee under 37 CFR 1.17(i), is submitted herewith.

Priority/Preliminary Matters

Applicant notes that the Preliminary Amendment filed on 6/18/2001 requested amendment on the first page to enter a specific reference to the prior applications. Given that one of those applications has since issued as a patent, Applicant resubmits an amendment to insert a specific reference to the prior applications.

Applicant believes that the referenced U.S. application on page 11 of the specification has abandoned, and an amendment to that effect is also made.

Applicant respectfully traverses the statement that "claims 10-11 get priority as of the filing date of the present application because the specification does not enable ... the presently claimed invention as of the filing date of the priority documents." Applicant first notes that claims 10-11 were included in the grandparent application as filed, U.S. Application 08/996,545. The '545 application was filed on December 23, 1997. Given that this is a continuation application, and the specification and claims 10 and 11 are word-for-word identical with the '545 application as filed in 1997, Applicant is entitled to priority as of the filing date of the '545 application. *See, e.g.*, the "Updated Filing Receipt" mailed 06/25/2002. Under 35 U.S.C. § 120 Applicant is entitled to a priority date as of the first filed application, that being the '545 application. Applicant further notes that the question of priority is separate from that of enablement. If claims are allowed, then Applicant is entitled to the priority date of the grandparent application.

Election/Restriction

Applicant affirms the election of the invention of group I, claims 10-11.

Claims Rejections - 35 U.S.C. § 112, second paragraph

Claim 10 is amended to address the concerns raised by the Examiner.

Claims Rejections - 35 U.S.C. § 112, first paragraph

The method as claimed is described in detail in the specification at page 3, lines 13-30; page 11, line 3 bridging page 12, line 2; and Example 3, page 13, line 25 through page 14, line 25.

The Office Action states that “enablement for a method for determining fungal Multi Drug Resistance (MDR) inhibition activity ... is considered unpredictable... [and] would require undue experimentation.” MPEP § 2164.04 explicitly states that the “examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention.” The sole factual argument raised is with respect to Example 4, i.e., a plasmid containing an internal portion of the *atrD* gene lacking about 500 base pairs at each of the N- and C-terminal ends. However, Example 4 does not relate to the pending claims; instead, Example 4 describes a method relating to withdrawn claims 13 and 14.

Claim 10 as presently amended is drawn to “a nucleic acid encoding an *atrD* protein consisting essentially of the amino acid sequence of SEQ ID NO:2.” The method of claim 10 is amply and fully described in Example 3. The method of claim 10 is fully and adequately set forth in the specification so as to teach how to make and use the claimed invention.

There is no showing of record that one of ordinary skill in the art would not be able to practice the method as described in the specification at page 3, pages 11 to 12, and Example 3. It is fully and explicitly enabled. The embodiment disclosed in Example 4 is related to an invention not claimed in the pending claims. The embodiment of Example 4 is claimed in claims 13 and 14 of the application as filed, which claims are withdrawn. The rejection under 35 U.S.C. § 112, first paragraph, is clearly inappropriate.

Applicant further notes that substantially similar claims to the pending claims have been allowed in other cases on a substantially similar disclosure. See, e.g., U.S. Patent No. 5,914,246 (same method applied to *Aspergillus fumigatus* AfuMDR1) and U.S. patent 6,060,264 (same method applied to same organism as this application, *Aspergillus nidulans*, but using *atrC* DNA).

For the foregoing reasons, it is submitted that the claims are fully and adequately described so as to allow one skilled in the art to make and/or use the invention.

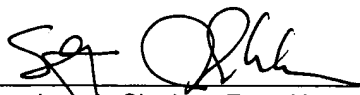
In view of the above amendments and remarks, it is respectfully submitted that all grounds of rejection and objection have been avoided and/or traversed. It is believed that the case is now in condition for allowance and same is respectfully requested.

If any issues remain, or if the Examiner believes that prosecution of this application might be expedited by discussion of the issues, the Examiner is cordially invited to telephone the undersigned attorney for Applicant at the telephone number listed below.

Also being filed herewith is a Petition for Extension of Time to October 27, 2003, with the appropriate fee. Authorization is given to charge payment of any additional fees required, or credit any overpayment, to Deposit Acct. 13-4213. A duplicate of this paper is enclosed for accounting purposes.

Respectfully submitted,

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